

## REMARKS

Favorable reconsideration of this application is requested in view of the following remarks. Claims 1-7, 9 and 11 are pending in the application. Reconsideration of the claims is respectfully requested.

In paragraph 2 on page 3 of the Office Action, claims 1-7, 9 and 11 were rejected under 35 USC §103(a) as being unpatentable over Zeiter et al. (6,494,491) in view of Dukatz (6,113,149). Applicants respectfully traverse the rejections.

First, Zeiter fails to teach or suggest at least a protective overlayer selectively applied on said image-receiving layer to form a second machine-readable indicia of varying thicknesses thereon as recited in Applicants' independent claims. In construing claims, the court in *Phillips* has recently emphasized that "claims must be read in view of the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303,1315 (Fed. Cir. 2005). In fact, the Federal Circuit explained that the specification is "'usually . . .dispositive. . . [and] the single best guide to the meaning of a disputed term.'" *Id.* (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582). For these reasons, the Federal Circuit confirmed that it is "entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Phillips*, 415 F.3d at 1317. Zeiter discloses that a transparent plastic film 10 has images 12, 14 on both sides a distance  $d$  apart. Col. 5, lines 23-25. At best, Zeiter discloses overlapping images separated by a plastic film in which additional uniform outer layers 22, 24 can be laminated onto the plastic film. Col. 6, lines 9-12. Zeiter's transparent layer 10 is not selectively applied on an image-receiving layer to form a second machine-readable indicia of varying thicknesses thereon. Applicants respectfully disagree with the Office Action's assertion that "the protective overlayer (10) further comprises a second identical image indicia (14) superimposed over the first image indicia." Applicants submit that "FIG. 3 of Zeiter shows a transparent plastic film 10 made up of two film layers 10a, b. The images 12, 14 have been printed on the outer faces of the film layers 10a, b." *See* Col. 5, lines 55-57.

Dukatz fails to remedy the deficiencies of Zeiter as Dukatz also fails to teach or suggest at least a protective overlayer selectively applied on said

image-receiving layer to form a second machine-readable indicia of varying thicknesses thereon. Rather, Dukatz merely provides a pseudo three-dimensional image having a protective transparent layer 20 laminated over a textured pattern 18. A second textured layer 22 is formed over all or a portion of the transparent layer 20 using screen-printing. *See* Col. 4, lines 44-65. Applicants agree with the assertion in the Office Action, that the second textured layer 22 is “not directly” formed on the textured pattern 18. Accordingly, Dukatz does not provide a protective overlayer selectively applied on an image-receiving layer to form a second machine-readable indicia of varying thicknesses thereon.

Second, Zeiter fails to teach or suggest at least a second machine-readable indicia. Rather, Zeiter discloses that as additional security one may employ colors that make a moiré pattern visible only under UV or IR light. Accordingly, Zeiter does not disclose an indicia being readable by a machine. Dukatz fails to remedy the deficiencies of Zeiter as Dukatz also fails to teach or suggest at least a second machine-readable indicia.

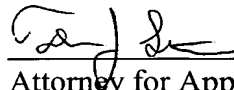
Further, Applicants submit that Applicants’ protective overlayer forming machine-readable indicia of varying thicknesses is novel and unobvious in that it has structure and function, which is required for patentability. Applicants submit that the protective overlayer selectively applied on the image-receiving layer to form a second machine-readable indicia of varying thicknesses enhances the machine readability. This specifies at least the required functional relationship to carry out Applicants’ invention and clearly defines the disclosed invention as required by section 112. “The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination.” *In re Miller*, 418 F.2d 1392, 1395; 164 USPQ 46, 48 (1969).

In view of the above remarks, Applicants respectfully submit that claim 1 is patentable over the cited references. Rejected independent claims 2, 6 and 7 recite one or more feature generally similar to those of claim 1 discussed above and, for similar reasons as discussed above, are believed to be patentable over the cited references. Because claims 3-5, 11 and 9 depend from claims 2 and 7, respectively, and include the features recited in the independent claims as well as additional features, Applicants respectfully submit that claims 3-5, 9 and 11 are also patentably distinct over the cited references.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Deposit Account No. 05-0225.

Respectfully submitted,



Attorney for Applicant(s)  
Registration No. 53,950

Thomas J. Strouse/mjl  
Rochester, NY 14650  
Telephone: 585-588-2728  
Facsimile: 585-477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.